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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,753	06/11/2001	Jose-Luis Abad-Peiro	CH919980004US1 (590.059)	6136
35195 7590 08/04/2009 FERENCE & ASSOCIATES LLC 409 BROAD STREET PITTSBURGH, PA 15143			EXAMINER TINKLER, MURIEL S	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 08/04/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/787,753	Applicant(s) ABAD-PEIRO ET AL.	
	Examiner MURIEL TINKLER	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/17/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application has been reviewed. Claims 1-20 are pending. The Office action is in response to the pre-appeal conference decision mailed on May 26, 2009. The rejection(s) are as follows.

Pre-Appeal Conference

This Office Action is being sent in response to the pre-appeal conference decision mailed on May 26, 2009. The panel has decided to withdraw the 35 USC 101 rejection(s) over claims 2, 3 and 18 and re-instate a new 35 USC 101 rejection over claims 1-20. A response to the Applicant's remarks from the Pre-Brief Conference request received on September 16, 2008 are shown below.

Response to Arguments

1. Applicant's arguments, see pages 2-3, filed September 16, 2008, with respect to the rejection(s) of claim(s) 2, 3 and 18 under 35 USC 101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 USC 101 over claims 1-20.
2. Applicant's arguments filed September 16, 2008 have been fully considered but they are not persuasive. The Applicant argues that: Rowney does not disclose a trusted third party that is not the merchant; and, the amended claims overcome the prior art

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because they include the use of a certified third party and the identity of the user need not be revealed to the merchant.

3. Regarding the argument that, Rowney does not disclose a trusted third party that is not the merchant and the argument that, the amended claims overcome the prior art because they include the use of a certified third party and the identity of the user need not be revealed to the merchant, the Examiner disagrees. Rowney discloses that a trusted and certified third-party (payment gateway computer system, via a host legacy system) is used to evaluate payment information, see column 4 (lines 40-59):

“Secure transmission of data is provided from a customer computer system to a merchant computer system, and for the further secure transmission of payment information regarding a payment instrument from the merchant computer system to a payment gateway computer system. The payment gateway system formats transaction information appropriately and transmits the transaction to the particular host legacy system. The host legacy system evaluates the payment information and returns a level of authorization of credit to the gateway which packages the information to form a secure transaction which is transmitted to the merchant which is in turn communicated to the customer by the merchant.”

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-20 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 (CAFC (2008)); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S.

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584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

6. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

7. Here, the Applicant's method and computer readable medium claims do not contain any hardware in the body of the claim (therefore, the entire claim is being executed solely using software). Thus, the claims are non-statutory.

8. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowney et al. (US 5,987,140), hereafter referred to as Rowney.

11. Regarding claims 1, 16, 17, 19 and 20, Rowney discloses:

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- a. A computerized method for securely transacting electronic commerce in an insecure network in the Abstract
 - b. Operating between a user and merchants, where user has commercial relationship with certified trusted third party in column 1 (line 37) through column 2 (line 6)
 - c. Utilizing a network link between the user and trusted third party and merchants in figure 1B
 - d. Utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42)
 - e. Utilizing a payment protocol (SET) which is more secure than the communications protocol in column 4 (lines 59-62).
 - f. Authentication using a certificate improving security of communications protocol in column 1 (line 37) through column 2 (line 6) and column 11 (lines 14-17).
12. Regarding claims 2 and 18, Rowney discloses a terminal interface in figure 1A (element 38).
13. Regarding claim 3, Rowney discloses a trusted third party in column 1 (line 37) through column 2 (line 6).
14. Regarding claims 4 and 6, Rowney discloses the information in claim 1. Rowney also discloses: permitting users to access a third party in column 2 (lines 7-42); a browsing tool for gathering formation, presenting an interactive window and allowing a user to choose competitive products in column 2 (lines 7-42); transmitting payment

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orders and paying a merchant in the Abstract; the use of the JAVA protocol in column 4 (lines 20-31); and, using JAVA applets in column 9 (lines 33-50).

15. Regarding claim 5, Rowney discloses providing confirmation of payment (the payment capture response) in figure 13F (element 925).

16. Regarding claims 7, 9, 10 and 12, see the rejection(s) of claims 1, 4 and 5 above.

17. Regarding claims 8 and 11, see the rejection(s) of claims 7 and 6 above.

18. Regarding claims 13 and 15, Rowney discloses receiving a request from a trusted third party for information in figure 4 and column 12 (lines 13-24) and establishing a trusted third party via an authentication/certificate in column 11 (lines 14-17). See also the rejection(s) of claims 1, 4 and 5 above.

19. Regarding claim 14, see the rejection(s) of claims 6 and 13 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art
Unit 3691

/M. T./
Examiner, Art Unit 3691